

Appl. No. 09/787,328  
Amendment dated May 6, 2004  
Reply to Office Action of February 6, 2004

### REMARKS

Applicants respectfully request entry of the Amendment and reconsideration of the claims. Claims 12-15 have been canceled. Claims 1, 2, and 10 have been amended to correct antecedent basis. Claim 7 has been amended to further clarify the invention. After entry of the Amendment, claims 1-3 and 6-11 are pending.

Applicants submit the Amendment is supported throughout the specification, including at page 5, lines 15-17, and raises no issues of new matter.

### Utility

The Examiner rejected claim 7 under 35 U.S.C. § 101 as directed to non-statutory subject matter. Applicants amended the claim as suggested by the Examiner. Withdrawal of the utility rejection is respectfully requested.

### Anticipation

Claims 1-3 and 9-11 were rejected under 35 U.S.C. § 102(e) as being anticipated by Benson et al. (U.S. Patent No. 6,468,758). Applicants respectfully traverse this rejection.

The Examiner alleges that Benson et al. teach a human DNA molecule (SEQ ID NO:68) that "comprises" nucleotides 121-732 of SEQ ID NO:3 and therefore inherently encodes the polypeptide consisting of SEQ ID NO:4. Applicants do not agree.

To anticipate the claims, Benson must teach every element of the claims either expressly or inherently. MPEP § 2131. Applicants teach that the open reading frame (ORF) is located at nucleotides 121-732 of SEQ ID NO:3. Alignment of SEQ ID NO:3 and SEQ ID NO:68 clearly shows that SEQ ID NO:68 only contains a portion of the ORF (nucleotides 198-732 of SEQ ID NO:3) and not the full length ORF (nucleotides 121-732 of SEQ ID NO:3) (See enclosed alignment).

The allegedly inherent characteristic must necessarily flow from the teachings of the applied prior art. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). The inherent characteristic must be established as a certainty, probabilities are not sufficient. *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981). The Examiner has failed

Appl. No. 09/787,328  
Amendment dated May 6, 2004  
Reply to Office Action of February 6, 2004

to establish with certainty that SEQ ID NO:68 encodes a polypeptide comprising SEQ ID NO:4. For example, if SEQ ID NO:68 is translated into a polypeptide from any of the start codons beginning at nucleic acid 5, 47, or 113, the translated polypeptide would contain 10 or less amino acids because of the location of stop codons downstream. In contrast, nucleic acids 121-732 of SEQ ID NO: 3 encode a polypeptide containing 203 amino acids.

Applicants submit the cited reference does not teach, either expressly or inherently, all the elements of the claims. Benson does not teach nucleotides 121-732 of SEQ ID NO:3. SEQ ID NO:68 only encodes a portion of the ORF. Consequently, it cannot be established with certainty that SEQ ID NO:68 encodes a polypeptide containing an amino acid sequence of SEQ ID NO:4. Accordingly, Applicants respectfully request withdrawal of the anticipation rejection.

#### Conclusion

In view of the above amendment and remarks, Applicants respectfully request a Notice of Allowance. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,

MERCHANT & GOULD P.C.  
P.O. Box 2903  
Minneapolis, Minnesota 55402-0903

Date: May 6, 2004

**23552**

PATENT TRADEMARK OFFICE



Eric E. DeMaster  
Reg. No. 55,107  
Tel.: 612.336.4621  
EED:lek